



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)
Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW**EXPRESS MAIL**

Mailing Label Number: EV746685677US

Date of Deposit: June 26, 2006

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" Service under 37 CFR 1.10 on the date indicated above and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

(Typed or printed name of person mailing paper or fee)

(Signature of person mailing paper or fee)

Docket Number (Optional)

450101-02897

Application Number

09/890,894

Filed

January 9, 2002

First Named Inventor

Yushi Ihara

Art Unit

2623

Examiner

Justin E. Shepard

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. 45,748
Registration number

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Signature

Paul A. Levy

Typed or printed name

(212) 588-0800

Telephone number

June 26, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



PATENT
450101-02897

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Yushi IHARA
Serial No. : 09/890,894
For : DATA TRANSMISSION/RECEPTION SYSTEM
Filed : January 9, 2002
Examiner : Justin E. Shepard
Art Unit : 2623
Confirmation No.: : 9637

745 Fifth Avenue
New York, NY 10151

EXPRESS MAIL

Mailing Label Number: EV746685677US

Date of Deposit: June 26, 2006

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" Service under 37 CFR 1.10 on the date indicated above and is addressed to: **Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

Adam Ahmed
(Typed or printed name of person mailing paper or fee)

A. Ahmed
(Signature of person mailing paper or fee)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1451

Sir:

Applicant requests a Pre-Appeal Brief Conference for review of the Final Rejection dated March 23, 2006 in the above-captioned application, in accordance with the July 12, 2005 Notice in the USPTO Official Gazette. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. Please consider the reasons stated herein.

I. REASONS FOR REQUEST

Applicants request a Pre-Appeal Brief Conference to review the rejection of claims 1-4 and 6-7 under 35 U.S.C. §103 as allegedly unpatentable over U.S. Patent No. 6,018,816 to Tateyama in view of U.S. Patent No. 6,460,635 to Kwon et al. (hereinafter, merely “Kwon”).

II. FACTUAL BASIS

The last entered amendment of the claims at issue, 1-4 and 6-7, was provided in Applicant’s December 12, 2005 reply to the Office Action mailed on August 10, 2005. Applicant filed a reply on May 30, 2006 in reply to a Final Action mailed on February 7, 2006. Applicant did not amend the claims at issue and made only arguments.

The February 7 Final Office Action rejected claims 1-4 and 6-7, in relevant part, because the Office Action asserted that term “protocol” used in the Tateyama and Kwon references was equivalent to the term “profile” as used in the claims at issue. Feb. 7, 2006 Office Action, page 4. Applicant contends that the definition of “profile” is provided in the specification as filed and does not equate to a “protocol” as alleged.

III. ARGUMENTS

THE CLAIMS ARE PATENTABLE OVER THE REFERENCES USING THE DEFINITION OF “PROFILE” AS PROVIDED IN THE SPECIFICATION

Independent claim 1 is representative and recites, *inter alia*:

“control means for controlling said input/output means to transmit to said data source side the profile information indicating a profile coped with by said picture processing means, as search results, responsive to the inputting of a command for searching a profile to said input/output means . . .” (emphases added).

Applicant disputes the equivalence, as asserted in the Office Action, between “profile” as used in the claims and “protocol,” a term of art. Applicant’s arguments are provided on pages 10-11 of the May 30, 2006 reply to the February 7, 2006 Final Action. Those arguments are stated clearly.

Applicant now also points to MPEP 2111.01 from which the following quotes are taken. “During examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004) . . . This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)” (emphasis added).

“Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999)” (emphasis added).

Applicant has defined “profile” in the specification: “The profile information denotes the type of the picture data that can be coped with by the printing device (5).” Par. [0098]. That definition indicates the particular one of the many meanings of “profile” that the claim is using and is not far from one dictionary definition of “profile:” “a set of data often in graphic form portraying the significant features of something.” *Merriam-Webster Online Dictionary*, 2005-2006. Neither the specification nor the claims give any indication that “profile” as used in the claims is undefined or ambiguous. Thus, there is no reason for the Office Action to seek extrinsic information and substitute “protocol,” a term of art in communications, for “profile,” as defined in the specification.

The Advisory Action of June 14, 2006 states, “This definition (of the claim term “profile”) is not the understood dictionary definition, and therefore not one that one of ordinary skill in the art would deduce from the reading of the claim.” This is not a correct statement of the law and not a proper application of the strictures of the MPEP.

Applicant contends that claim 1 is patentable over Tateyama and Kwon when using the definition of “profile” as defined in the specification.

Claims 2-4 and 6-7 are believed patentable for at least the same reasons as claim 1.

In view of the foregoing remarks and arguments, it is believed that claims 1-4 and 6-7 in this application are patentable and Applicant respectfully requests early passage to issue of the present application.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicant

By: 

Paul A. Levy
Reg. No. 45,748
(212) 588-0800